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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/766,435	01/19/2001	John Michael Friel	6258-003	7158

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EXAMINER

JASMIN, LYNDIA C

ART UNIT PAPER NUMBER

3627

DATE MAILED: 10/06/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/766,435

Applicant(s)

FRIEL ET AL.

Examiner

Lynda Jasmin

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 January 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 19 January 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4,5,6,8. 6) ☐ Other: _____

DETAILED ACTION

1. The information disclosure statement filed September 11, 2003 has not been initialed since the prior art was already cited in IDS paper no. 5

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1, 3-6, 8-10, 17-21 and 24-26 are rejected under 35 U.S.C. 102(e) as being anticipated by Jahn et al. (6,330,487).

Jahn et al. discloses a paint manufacturing method and system with steps of receiving each of a plurality of fluid prepaints at different ones of a plurality of inputs of a fluid component mixing system (raw material and resin into a paint manufacturing control), determining at a computer system (120) a first fluid prepaint ratio comprising a ratio to produce a first base paint (as illustrated in Figure 6A and 6B) selected from a plurality of base paints types that can be formulated from the plurality of fluid prepaints col. 6 line 67-col. 7, col. 7 lines 7), mixing the plurality of fluid prepaints in accordance with the first ratio to form at an output of the mixing system the first base paint (paint material 90). Further, the step of determining a second fluid prepaint ratio

and mixing mixing the plurality of fluid preprints in accordance with the second ratio to form at an output of the mixing system the second base paint is inherently recited (multiple models stored within the computerized virtual paint manufacturing and application system).

Jahn et al. further discloses the first and second base paints have different sheen level application characteristics, the sheen level characteristics being selected from the group consisting gloss sheen (col. 4, lines 45-58).

Jahn et al. further discloses the steps of receiving at the computer system (120) sensor data indicating a volume of each of the plurality of fluid preprints entering the mixing system (via batch control 102), and sending a signal from the computer system to the mixing system to dynamically adjust a flow of each of the fluid preprints based on the received sensor data (col. 3, lines 28-31). The computer system (120) includes a distributed computer system (via network 169) comprising multiple processing servers (160) and database computers (148, 152 and 156).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of

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the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

6. Claims 2, 7, 11-16, 22, 23 and 27-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jahn et al., in view of Cane (5,493,840).

Jahn et al. discloses all the elements of the claimed invention, however, fails to explicitly disclose tinting the base paint, adding water and having a plurality of valves to regulate flow entering the mixing system.

Cane discloses the concept of providing flowable colorant in a coating composition with the step of tinting the first base paint (with colorant 1) to form a first colored paint (in-store tinting). Cane further discloses that the coating composition is provided with a moisturizing device, which contained water. Cane also discloses a plurality of electrically adjustable valves (34) each configured to regulate a flow entering a different mixing system input and sending a signal to the mixing system to control each of the plurality of valves (col. 10, lines 33-57). Cane further discloses receiving a first customer order comprising a first paint quantity and a first paint type identifier (via bar code 53b), and determining at computer system (17) the first ratio based on the first paint type identifier (col. 9, lines 10-33).

From this teaching of Cane, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have provided the virtual paint manufacturing system of Jahn et al. to include the coating composition and order process taught by Cane in order to facilitate in-store tinting based on customer orders.

As per claims 14-16 and 30, the Jahn et al. and Cane combination fail to explicitly disclose that the mixing is at a point of sale retail location with payment processing. However, it is well known in the manufacturing business art to provide dispenses with ingredients at a retail purchase point of sale based upon specification by a retail customer and the Examiner takes Official Notice as such.

Conclusion

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Costanza, Yon et al., Jammes et al., Bartholomew et al., Durham, Arneson et al. Howlett et al. and Yauk et al. are cited as art of interest.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lynda Jasmin whose telephone number is (703) 305-0465. The examiner can normally be reached on Monday- Friday (8:00-5:30) alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert P Olszewski can be reached on (703) 308-5183. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 308-1113.

Lynda Jasmin
Examiner
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